

*Application No. 10/625387**Page 9**Amendment
Attorney Docket No. E30.2H-11235-US01***Remarks**

This Amendment is in response to the Office Action dated **January 17, 2006**.
Claims 16-17, 21-28, and new claims 30 and 31 remain in the application.

In the Office Action the Examiner objected to the title of the application; objected to the Abstract; and objected to the paragraphs 170, 171, 206, 210, 211, 218-221, 224, and 228, of the specification. Applicant has amended the specification as identified above. Applicant respectfully asserts that the amendments to the specification herein overcome the objections as raised by the Examiner. Applicant respectfully asserts that the objections to the specification related to typographical errors and matters as to form. Applicant respectfully asserts that the amendments to the specification herein do not impact the claims as presented for consideration in this application.

The Examiner next rejected claims 15-18 and 29, asserting 35 U.S.C. §102(b) alleging the same to be anticipated by Theobald 5,567,036.

With respect to 35 U.S.C. §102, the Federal Circuit has held that prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim. *Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, 225 U.S.P.Q. 253 (Fed. Cir. 1985); *Atlas Power Co. v. E.I. DuPont DeNemours*, 750 F.2d 1569, 24 U.S.P.Q. 409 (Fed. Cir. 1984); *American Hospital Supply v. Travenol Labs.*, 745 F.2d 1, 223 U.S.P.Q. 577 (Fed. Cir. 1984).

The Theobald '036 reference as cited by the Examiner at minimum fails to teach, disclose, and/or suggest an LED mount, at least one first clip engaging one of a plurality of LED's and one of the mounts, and a retaining clip engaging the first clip and one of the LED mounts. Applicant respectfully asserts that the Theobald '036 reference fails to teach all of the features of Applicants invention as claimed herein. Applicant respectfully requests that the rejection of claims 16-17, 21-28, and/or 30-31, pursuant to 35 U.S.C. §102(b) be withdrawn.

The Examiner next rejected claim 19 pursuant to 35 U.S.C. §103 asserting Theobald '036 in view of Machida 6,411,022. Applicant respectfully traverses the rejection of claims herein pursuant to 35 U.S.C. §103 for the reasons identified herein.

The Theobald '036 reference is directed to an LED marker lamp for directing light in at least three different directions. In the Theobald '036 reference, the LED's are affixed

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directly to a circuit board. One circuit board is horizontal and two circuit boards extend upwardly from the horizontal circuit board. No suggestion, teaching, or disclosure is provided in the Theobald '036 reference for the provision of first clip engaging at least one of a plurality of LEDs and at least one of a plurality of mounts, and a retaining clip releasably engaging a first clip and at least one of a plurality of LED mounts. In addition, there is no suggestion, teaching, or disclosure in Theobald '036 for the provision of an insulator clip engaging at least one of a plurality of LEDs, and at least one of a plurality of mounts, and a retaining clip releasably engaging an insulator clip and at least one of a plurality of LED mounts. Theobald '036 does not suggest to a person of ordinary skill in the art the features of Applicants claims herein.

The Machida '022 reference teaches the use of a vehicle lamp having a base unit 7 where individual LEDs may be snap fit to certain locations on the base unit 7 through the use of engaging pieces 10. (Retaining prongs) The Machida '022 reference does not suggest, disclose, nor teach the provision of a first clip engaging at least one of a plurality of LEDs and at least one of a plurality of mounts, and a retaining clip releasably engaging a first clip and at least one of a plurality of LED mounts. In addition, there is no suggestion, teaching, or disclosure in the Machida '022 reference for the provision of an insulator clip engaging at least one of a plurality of LEDs and at least one of a plurality of mounts, and a retaining clip releasably engaging an insulator clip and at least one of the plurality of LED mounts.

Machida '022 does not suggest to a person of ordinary skill in the art the features of Applicants claims herein.

In addition, no suggestion or motivation is provided in either the Theobald '036 or Machida '022 references individually or in combination to provide the elements of Applicants claims herein. Further, no suggestion or motivation is provided in either the Theobald '036 or Machida '022 reference for combination with each other, or with any other reference, to provide Applicants claims herein. A person of ordinary skill in the art would not have gained any suggestion, teaching, or understanding following a review of the Theobald '036 and/or Machida '022 references as to how accomplish Applicants invention herein, because no teaching is provided related to Applicants mounting mechanism. Applicant respectfully asserts that only through the impermissible use of hindsight, where Applicants disclosure is used as a blueprint, may a rejection under 35 U.S.C. §103 be raised.

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When an attempt is made to combine two references A and B, or to change a single reference, a prima facie case of obviousness has not been established if no suggestion why or reasons or motivation for combining A and B appears explicitly or implicitly in either A or B, or both in combination. Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent a teaching or suggestion supporting the combination. *In re Fine*, 5 USPQ 2d, 1596 (1988) (Fed. Cir. 1989); see also *In re Laskowski*, 10 USPQ 2d 1397 (Fed. Cir. 1989). In this case, no suggestion for combination exists.

In addition, in the case of *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (CAFC 1999), the Court of Appeals for the Federal Circuit has stated that the case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references and that one of ordinary skill in the art would have been motivated to select the references and combine them, and it was error to not elucidate any factual teachings, suggestions, or incentives from the prior that showed the propriety of combination. The Federal Circuit in *Dembiczak* further stated that combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability which is the essence of hindsight.

For the reasons identified above, Applicant respectfully asserts that it is improper for the Examiner to assert a 35 U.S.C. §103 rejection of Applicants claims herein when neither of the references as relied upon by the Examiner namely Theobald '036 and/or Machida '022 teach, suggest, and/or disclose the use of a first clip and a retaining clip or, the use of an insulator clip and retaining clip as claimed by Applicant herein. Applicant therefore respectfully asserts that the rejection pursuant to 35 U.S.C. §103 is improper. Applicant respectfully requests that the rejection pursuant to 35 U.S.C. §103(b) withdrawn.

Applicant respectfully asserts that claims 16-17, 21-28, and new claims 30 and 31, are in condition for allowance over the references as cited by the Examiner. Applicant respectfully requests reconsideration and allowance of claims 16-17, 21-28, and new claims 30 and 31, herein.

Should the Examiner have any questions concerning this Amendment, then the Examiner is cordially invited to contact the undersigned by telephone, facsimile, and/or E-Mail at

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the below identified address. If an extension of time is required to make this response timely and no separate petition is enclosed, Applicant hereby petitions for an extension of time sufficient to make the response timely. Applicant has enclosed herewith a Petition for a two month extension of time with the appropriate fee of \$450.00. In the event that the response herein requires the payment of additional government fees and payment is not enclosed, please charge Deposit Account No. 22-0350.

Conclusion

It is believed that claims 16-17, 21-28, and 30-31, in the present application are in condition for allowance in view of the foregoing. Applicant respectfully requests reconsideration of the claims herein and that the rejections be withdrawn and the claims allowed. Applicant respectfully requests the Examiner to reconsider the claims as amended herein which Applicant believes puts the application in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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